The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte RALF WOLLESCHENSKY,
ROBERT GRUB, SIMON ULRICH,
MARTIN GLUCH, ANDREAS FAULSTICH,
AND MARTIN VOELCKER

_____

Appeal No. 2002-1015
Application 09/129,339

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ON BRIEF

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Before THOMAS, KRASS, and DIXON, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

In a paper bearing an April 28, 2003 Certificate of Mailing date, appellants request rehearing of our decision dated February 26, 2003, in which we affirmed the examiner's rejections of various claims under 35 U.S.C. § 102 and 35 U.S.C. § 103. Because two months from the decision date of February 26, 2003 falls on a Saturday, appellants' filing of the Request for

Rehearing on the next business day, Monday, April 28, 2003, the request is considered timely.

In the Request for Rehearing, appellants assert that we have misapprehended and overlooked several points in rendering our decision and that we have introduced a new ground of rejection in our previous decision. With these assertions we strongly disagree.

We have considered in detail appellants' positions with respect to each of the noted points listed in the Request for Rehearing but are unpersuaded by any of them. What is most telling of the arguments presented is that appellants argue in essence the disclosed invention rather than the subject matter of claim 25 on appeal. Thus, they invite us to read from the specification limitations not actually present in claim 25 on appeal, the only claim argued by appellants in the brief and reply brief. The scope of claim 25 goes well beyond that which is asserted according to the arguments presented.

Contrary to the general assertions made in the Request for Rehearing, we did understand the technology even to the point of

understanding it was derived from so-called adaptive optics. Appellants' various references in the Request for Rehearing to arguments made about this topic at the oral hearing are misplaced. There is no adaptive optics per se recited in claim 25 on appeal. We made reference at page 9 of our earlier decision regarding appellants' arguments made in the principal brief on appeal as well as the reply brief regarding the theoretical bases of the disclosed invention. There we concluded as we do now that the theoretical bases of the disclosed invention was well understood by us, but the nature and breadth of scope of the subject matter in independent claim 25 on appeal led us and continue to lead us to conclude that the claim is anticipated by the teachings and suggestions in Hakamata as argued by the examiner and embellished upon by us in our prior decision.

A major focus of our analysis in our prior decision was that to the extent recited in claim 25, the subject matter of Hakamata meets claim 25. Appellants have not persuaded us what features actually recited in claim 25 were not met by Hakamata. Appellants do not appear to us to appreciate the broad scope of

claim 25, since it reads upon the prior art to Hakamata, even if the disclosed but unclaimed features may represent improvements over the prior art, especially those in adaptive optics.

At page 4 of our prior decision, we took great effort to explain to the reader the nature of the various amendments made by appellants to the Background of the Invention, the objects and Summary of the Invention and the new Abstract provided in the amendment of September 28, 1998. It was explained that the type of "control" set forth in those portions of the specification for the control of a wave front modulator is in fact to displace and shape the focus of the light beam in object space. There is no such recitation in claim 25 on appeal. Even though such a recitation is not present in claim 25 on appeal, to us at the time the original decision was rendered, we attempted to make clear to appellants that we understood the nature of the control as disclosed, but not claimed. Moreover, we made it clear that no modulation per se was claimed.

Even if we consider the nature of the definition of wavefront modulator presented at page 4 of the reply brief as reproduced from specification page 2, we remain similarly unpersuaded. There is no recitation in claim 25 that a wavefront modulator deliberately influences the phase and/or amplitude of a

light wave. What is in fact recited to be the function attributed to the controllable wavefront modulator of claim 25 is merely a broad recitation of "to control the shape of the wavefront of a beam in the illumination beam path." It is this actual broad recitation that we and the examiner have emphasized in our respective views is actually met by the teachings of Hakamata.

Appellants' arguments of the general description of the invention beginning at page 5 of the Request for Rehearing is similarly misplaced. There is no recitation in claim 25 of displacing the focus in object space in a z axial direction. Clearly, this a feature of the disclosed but unclaimed invention. Similarly, the assertion at the top of page 6 that the Board's reasoning ignores much of what is disclosed above in context buttresses our earlier point that appellants are arguing in effect their disclosed rather than the actual claimed invention in claim 25 on appeal.

Returning again to appellants' mention at the bottom of page 4 of the Request for Rehearing of appellants' definition of a wavefront modulator at page 2 of the specification, it goes without saying that to the extent a wavefront modulator is defined, it was known in the art. Examples are given there such as reflecting optical elements and transmitting optical elements. A discussion in this paragraph at the middle of page 2 of the specification as filed is detailed in the initial paragraph at the top of page 9 of the specification as filed. There, it is also stated (with our emphasis here) that "wavefront modulators are currently obtainable in different constructions." The discussion continues by making reference to Figures 5A-5D of known controllable wavefront modulators. This is essentially the same discussion of the definition of these devices at page 2 of the specification as filed. We discussed in the paragraph bridging pages 7 and 8 of our prior decision the correlation the examiner has made in the prosecution of this application of the liquid crystal device in Hakamata to the liquid crystal modulator of appellants' Figure 5D. The top of page 4 of the Request for Rehearing even lists other prior art devices that use controllable wavefront modulators. From all of these

considerations, appellants appear to be attempting to secure broad patent protection for a known device.

At the top of page 4 of our prior decision we repeated the language "to control the shape of the wavefront of a beam in the illumination beam path" from claim 25 and then we went on to state that it "is this language that is stated at the bottom of page 9 of the brief to be 'the main issue to be decided on appeal'." Appellants' urgings at page 8 of the Request for Rehearing that it is the Board who has unduly limited appellants' claim 25 on appeal are clearly misplaced. No other feature than the quoted feature of claim 25 was argued in the brief and reply brief before us when we rendered our prior decision. Even so, we also explained, beginning at page 5 of our earlier decision, all of the elements of claim 25 were correlated to teachings and showings in Hakamata's Figure 7 just as the examiner did at page 3 of the answer.

As plainly set forth in our prior decision, we agreed with and expanded upon slightly the examiner's reasons of unpatentability of the various claims on appeal under 35 U.S.C. § 102 and 35 U.S.C. § 103 as set forth in the final rejection and answer. We addressed and found unpersuasive appellants' arguments in the brief and reply brief. Appellants' are now hard

pressed in our view to presently persuasively argue that we have set forth a new ground of rejection in our prior decision.

In view of the foregoing, we have considered in detail appellants' Request for Rehearing but remain unconvinced by it.

DENIED

James D. Thomas Administrative Patent Judge	)	
Errol A. Krass Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
Joseph L. Dixon Administrative Patent Judge	)	

JDT/cam

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